

**II. The 35 U.S.C. §112, ¶1 Rejection**

Claims 1-11 stand rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. More specifically, the Office Action asserts that the written description supports neither the electronic ticket storage device of claims 1, 6, and 11, nor the sending, receiving, and recording of electronic tickets and money as recited in claims 6-10. Applicant respectfully traverses this rejection, as the application clearly supports each of these claims elements.

Regarding the electronic ticket storage device, as understood by Applicant, the Office Action alleges that there is no support because Applicant's disclosure describes implementing a money module and a trusted agent as separate components. That is, the Office Action states that the "disclosure of the instant application is directed to a transaction device comprising a trusted agent and a money module. This arrangement for separate trusted agent and money module components, is in keeping with the objectives of the instant application for a flexible, anonymous and trusted electronic system . . . .It is not established how the proposed claims, which set forth an invention that teaches away from separate components, could be supported by a disclosure that describes an invention having separate components, and the benefits and uses of the invention that is comprised of the separate components."

Applicant submits that while the instant application discloses providing a money module and a separate trusted agent, it also clearly supports the claimed electronic

ticket storage which embodies features of both the money module and the trusted agent. For example, the instant specification recites the following (specification at page 35, lines 10-16; US Patent No. 5,557,518 at col. 20, lines 4-12) (emphasis added):

*It may be noted that instead of the trusted agent 120 and money module 6 being embodied as discrete tamper-proof components, they may be fabricated as one tamper-proof module. In this case, it would not be necessary to establish a secure session for communication between trusted agent 120 and money module 6 in the same transaction device 122. However, discrete money modules 6 and trusted agents 120 are preferable in that such a configuration allows for greater application flexibility.*

Indeed, this passage unambiguously and expressly conveys to the ordinarily skilled artisan that in an alternative embodiment of the invention a money module and a trusted agent may be integrated as a discrete component, viz., an electronic ticket storage device. As this passage also explains, the illustrative embodiment shows money modules 6 and trusted agents 120 implemented discretely because “such a configuration allows for greater application flexibility”. For example, the ordinarily skilled artisan will appreciate that such a discrete or modular configuration allows the electronic ticket system to be easily integrated with any electronic money scheme (e.g., as a co-processor). This flexibility associated with such a configuration thus simply represents an attribute of an illustrative embodiment of the invention—it does not limit the invention to such a configuration. And, as discussed, the specification expressly conveys that an alternative configuration provides both the money module and the trusted agent implemented as a discrete component.

Regarding the alleged lack of support for sending, receiving, and recording of electronic tickets and money, the Office Action states the following:

The disclosure of the instant application appear to disclose sending and receiving tickets through the trusted agents, first, and then the sending and receiving of the electronic money, second. Further, the recording step is not disclosed. The instant disclosure does establish a commit function, but this does not appear as a recording step as necessitated by the claims.

First, Applicant submits that the specification expressly discloses that “the order of exchanging electronic merchandise and money may be reversed” such that “electronic money may be transferred . . . first followed by the transfer . . . of electronic merchandise.” See specification at p. 42, lines 16-22; US Patent No. 5,557,518 at col. 23, lines 53-61. Additionally, Applicant respectfully notes that Applicant’s claimed invention is not limited to an order of sending/receiving tickets vs. sending/receiving electronic money, and embraces, *inter alia*, either order.

Second, Applicant submits that the specification also expressly supports the “recording step” of claims 6-10. Although the Office Action asserts that the commit function does not “appear” to support the “recording step as necessitated by the claims”, the commit/abort protocol as implemented in connection with the purchase of electronic merchandise, in fact, clearly supports the claimed recording elements.

Applicant’s claimed recording steps refer to recording that certain electronic tickets/electronic money transfer events have been effected (e.g., “electronic money was sent”, “received said electronic ticket”, etc.). As expressly described in the specification, according to the commit/abort protocol, a ticket is provisionally stored in a

ticket holder until the payment transaction has committed. Once committed, the ticket is permanently held and may be presented, and the transaction log is updated. See, e.g., specification at p. 23, line 24 et seq., including p. 25, lines 1-3; US Patent No. 5,557,518 at col. 13, line 37 et seq., including col. 14, lines 20-22. See also, specification at p. 17, lines 5-6; US Patent No. 5,557,518 at col. 9, lines 60-61 ("A Ticket Holder function 148 . . . stores . . . tickets 8"). Similarly, electronic money is provisionally stored, and upon commitment becomes permanent and available for presentment (and stored information in the transaction log is updated). See, e.g., specification at p. 25, lines 15-21; US Patent No. 5,557,518 at col. 14, lines 38-47.

As described in the specification, during a purchase of electronic merchandise, *in response to various specified transaction events* (e.g., sending or receiving of a ticket or money, ticket approved as correct, acceptance of merchandise, etc.), tickets and electronic money are provisionally and/or permanently stored in accordance with the commit/abort protocol. See specification at p. 31, line 1 through p. 44, line 13, including, e.g., p. 33, lines 8-12, p. 34, lines 11-13; US Patent No. 5,557,518 at col. 17, line 41 through col. 24, line 63, including, e.g., col. 18, lines 60-65, col. 19, lines 37-39. Applicant respectfully submits that the disclosed provisional and permanent storage of an electronic ticket and/or electronic money according to a commit/abort protocol in connection with the disclosed purchase of electronic merchandise transaction expressly and clearly supports the "recording" elements as claimed.

Accordingly, for at least the foregoing reasons, Applicant submits that the application reasonably conveys to an ordinarily skilled artisan that at the time of filing

Applicant was in possession of the claimed invention. Thus, the rejection of claims 1-11 under 35 USC §112, ¶1 should be withdrawn.

**III. Conclusion**

In view of the above remarks, Applicant respectfully submits that the application is in condition for allowance. Reconsideration and withdrawal of the outstanding rejections is respectfully requested and allowance of all pending claims is respectfully submitted.

If any outstanding issues remain, or if the Examiner has any suggestions for expediting allowance of this application, the Examiner is invited to contact the undersigned at the telephone number below.

The Examiner's time and attention to this matter are greatly appreciated.

Respectfully submitted,

MORGAN & FINNEGAN, L.L.P.

Dated: July 3, 2001

By: 

David V. Rossi

Registration No. 36,659

**CORRESPONDENCE ADDRESS:**

MORGAN & FINNEGAN, L.L.P.

345 Park Avenue

New York, New York 10154

(212) 758-4800 Telephone

(212) 751-6849 Facsimile